



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/763,214

01/26/2004

Timothy L. Kohler

03630.000178.1

6558

5514

7590

12/03/2008

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HANG, VU B

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,214	Applicant(s) KOHLE ET AL.	
	Examiner Vu B. Hang	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 13-18, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13-18, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 8-12,27,28,30,31,36,46,47,49,50,65,66,68,69,75 and 76.

DETAILED ACTION

- This office action is being issued in response to applicant's communication filed on 08/21/2008.
- Claims 1-7, 13-17, 19-26, 29, 32-35, 38-45, 48, 51-55, 57-64, 67 and 70-74 have been elected for examination.
- Claims 19, 38 and 57 have been cancelled.
- Claims 1-7, 13-18, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74 are pending in the application.

Election/Restrictions

1. Claims 27-28, 30-31, 36, 46-47, 49-50, 65-66, 68-69 and 75-76 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/14/2008. The examiner agrees that Claim 1 is generic to species I and II, which includes Claims 18, 37 and 56. Therefore, Claims 18, 37 and 56 are included for examination.

Response to Arguments

2. Applicant's arguments filed 08/21/2008, with respect to the examined Claims 1-7, 13-18, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74, have been fully considered and are persuasive. The wrong set of claims was examined for the office action mailed on 06/09/2008.

Art Unit: 2625

The previous rejections of Claims 1-7, 13-18, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74 have been withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 13-15, 20-26, 29, 32-35, 39-45, 48, 51-55, 58-64, 67 and 70-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider et al. (US Patent 5,625,758).

5. Regarding **Claim 1**, Schneider discloses a method for determining the layout of print data printed by a printer onto a recording medium (see Fig. 1, Fig.4, Col.2, Line 36-45, Col.4, Line 41-53 and Col.6, Line 15-31) [Note: the data exchanging for the configuration information between the host computer and the printer determines the imposition layout for the image placements" on the recording medium and processing by the folding and/or cutting device], in which the recording medium is processed by a target device different from the printer (see Col.4, Line 41-53 and Col.5, Line 9-18) [Note: the examiner views the folding device as the target device], comprising: determining, via communication with the printer, the printing capabilities of the printer (see Fig.1 (1,2,3,4), Col.4, Line 3-15, Col.4, Line 23-40 and Col.7, Line 52-59) [Note: the printing capabilities information includes the appropriate paper format and thickness for the printer]; determining via communication with the target device the processing capabilities of the

Art Unit: 2625

target device (see Fig.1 (1,2,3,4), Col.4, Line17-27, Col.4, Line 41-53 and Col.5, Line 8-18)

[Note: the processing capabilities includes the appropriate paper type and thickness for the folding and/or cutting device]; and determining the layout of the print data used for color adjustment related to the printer (see Fig.1 (1,2,3,4) and Col.5, Line 54 – Col.6, Line 6), based on the compatible capabilities between the priming capabilities of the printer and the processing capabilities of the target device (see Fig.1 (1,2,3,4), Col.3, Line 18-28, Col.4, Line 41-53 and Col.5, Line 9-18).

6. Regarding **Claim 2**, Schneider further discloses the step of communicating with the printer so as to negotiate a layout (see Col.3, Line 18-28, Col.4, Line 41-53 and Col.5, Line 9-18). [Note: the data exchanging for the configuration information between the host computer and the printer determines the imposition layout for the image placements" on the recording medium and processing by the folding and/or cutting device.]

7. Regarding **Claim 3**, Schneider further discloses the step of communicating with the target device so as to negotiate a layout (see Col.3, Line 18-28, Col.3, Line 44-47, Col.4, Line 41-53 and Col.5, Line 9-18) [Note: the data exchanging for the configuration information between the host computer and the printer determines the appropriate paper type and thickness for the folding and/or cutting device].

8. Regarding **Claim 4**, Schneider further discloses the steps of communicating the layout of the print data to the printer and configuring the printer in accordance with the communicated layout (see Col.5, Line 9-18 and Col.6, Line 14-31). [Note: the data exchanging for the configuration information between the host computer and the printer determines the imposition

Art Unit: 2625

layout for the image placements on the recording medium and processing by the folding and/or cutting device.]

9. Regarding **Claim 5**, Schneider further discloses the layout is communicated to the printer in a print job sent to the printer for printing the print data (see Fig. 1, Col.4, Line 17-27, Col.5, Line 9-18 and Col.6, Line 14-31).

10. Regarding **Claim 6**, Schneider further discloses the steps of communicating the layout of the print data to the target device and configuring the target device in accordance with the communicated layout (see Col.3, Line 18-28, Col.3, Line 44-47, Col.4, Line 41-53 and Col.5, Line 9-18).

11. Regarding **Claim 7**, Schneider further discloses the printing capabilities are determined through communication with the printer (see Fig. 1, Col.3, Line 7-12, Col.3, Line 18-29 and Col.4, Line 37-40). 11. Regarding Claim 13, Schneider further discloses the printing capabilities include at least one valid size for the recording medium (see Col.4, Line 17-22 and Col.5, Line 9-18) and at least one printable area on the recording medium (see Fig.4 and Col.6, Line 15-31).

12. Regarding **Claim 14**, Schneider further discloses the processing capabilities include at least one valid size for the recording medium (see Col.4, Line 17-22 and Col.5, Line 9-18) and at least one area on the recording medium that can be processed (see Col.5, Line 9-18 and Col.5, Line 54 - Col.6, Line 6).

13. Regarding **Claim 15**, Schneider further discloses the processing capabilities include at least one area on the recording medium that cannot be processed (see Col.5, Line 34-42 and Col.5, Line 54 - Col.6, Line 6).

14. Regarding **Claims 20-26**, the rationale provided for the rejection of Claims 1-6 are incorporated herein.
15. Regarding **Claim 29**, Schneider further discloses the processing capabilities are determined through communication with the target device (see Col.5, Line 9-18 and Col.7, Line 52-66).
16. Regarding **Claims 32-35**, the rationale provided for the rejection of Claims 13-16 are incorporated herein.
17. Regarding **Claims 39-45**, the rationale provided for the rejection of Claims 1-7 are incorporated herein.
18. Regarding **Claim 48**, the rationale provided for the rejection of Claim 29 is incorporated herein.
19. Regarding **Claims 51-55**, the rationale provided for the rejection of Claims 13-17 are incorporated herein.
20. Regarding **Claims 58-64**, the rationale provided for the rejection of Claims 1-7 are incorporated herein.
21. Regarding **Claim 67**, the rationale provided for the rejection of Claim 29 is incorporated herein.
22. Regarding **Claims 70-74**, the rationale provided for the rejection of Claims 13-17 are incorporated herein.

Art Unit: 2625

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (US Patent 5,625,758) and Stearns et al. (US Patent 5,699,450).

25. Regarding **Claim 16**, Schneider discloses the processing capabilities include at least one valid size for the recording medium (see Col.4, Line 17-22 and Col.5, Line 9-18) and at least one area on the recording medium that can be processed (see Col.5, Line 9-18 and Col.5, Line 54 - Col.6, Line 6), but fails to disclose a minimum distance of separation for the images on the recording medium that can be processed. Schneider, however, teaches providing various color patches (marks) as control elements for adjusting the colors of the print data (see Col.5, Line 54-- Col.6, Line 6), and that certain areas of the image data may be used for color measurements (see Col.5, Line 54 - Col.6, Line 6). Schneider further teaches providing position coordinates and dimension of the color patches to be measured to press (see Col.5, Line 54 - Col.6, Line 6). Stearns teaches arranging the color patches in predetermined orientation and spacing them apart within focal precision of the sensor for the purpose of sensing and measuring the color patches (see Fig.3 and Col.8, Line 26-51).

26. Schneider and Stearns are combinable because they are from the same field of endeavor, namely printing communication systems. At the time of the invention, it would have been obvious for one skilled in the art to include in the layout information for the images (color patches), a minimum distance of separation for the images on the recording medium that can be

Art Unit: 2625

processed. The motivation would be to arrange the images (color patches) at certain locations on a print medium so they can be measured and processed for the color correction process. The predetermined arrangement/layout of the images would enable specific processing that requires the images to be placed at certain locations on the print medium. For the color patches, the specified layout and spacing would ensure that the color patches will be measured by a reading/sensing device.

27. Regarding **Claim 17**, Schneider discloses the printer is a color printer (see Col.7, Line 22-27), the print data includes color patches for performing color calibration of the color printer (see Col.5, Line 54 - Col.6, Line 6 and Col.6, Line 21-57), and the target device is a color measuring device (see Col.5, Line 54 - Col.6, Line 6 and Col.7, Line 60-67). Schneider fails to disclose that the processing capabilities include a minimum distance of separation for the images on the recording medium that can be processed. Schneider, however, teaches providing various color patches (marks) as control elements for adjusting the colors of the print data (see Col.5, Line 54--Col.6,Line 6), and that certain areas of the image data may be used for color measurements (see Col.5, Line 54 - Col.6, Line 6). Schneider further teaches providing position coordinates and dimension of the color patches to be measured to press (see Col.5, Line 54 - Col.6, Line 6). Stearns teaches arranging the color patches in predetermined orientation and spacing them apart within focal precision of the sensor for the purpose of sensing and measuring the color patches (see Fig.3 and Col.8, Line 26-51).

28. At the time of the invention, it would have been obvious for one skilled in the art to include in the layout information for the color patches, a minimum distance of separation for the images on the recording medium that can be processed. The motivation would be to arrange the

Art Unit: 2625

color patches at certain locations on a print medium so they can be measured and processed for the color correction process. The predetermined arrangement/layout of the color patches would enable the color measurement process, which requires the color patches to be placed at certain locations on the print medium. The specified layout and spacing would ensure that the color patches will be measured by a reading/sensing device.

29. Claims 18, 37 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al. (US Patent 5,625,758).

30. Regarding **Claim 18**, Schneider discloses that the target device could be a folding device (see Col.4, Line 41-47 and Col.5, Line 15-18), a cutting device (see Col.5, Line 15-18), a color measuring device (see Col.5, Line 54 - Col.6, Line 6 and Col.7, Line 60-67), a turn-over device (see Col.5, Line 9-18) or finishing device (see Col.5, Line 9-18). Schneider fails to disclose that the target device can be selected from a stamp reader, a bar code reader, an automatic scoring device, an automatic binding device and an automatic stamping device. Schneider, however, teaches that the print data communication process can be applied to any areas of the printing process which can operate independently from the printing press (see Col.3, Line 44-47). At the time of the invention, it would have been obvious for one skilled in the art to use a specific processing or finishing device as the target device. The motivation would be to perform specific post-print processing on the recording medium, such as applying a specific cutting, binding, stitching or finishing on the printed recording medium.

31. Regarding **Claim 37**, the rationale provided for the rejection of Claim 18 is incorporated herein.

Art Unit: 2625

32. Regarding **Claim 56**, the rationale provided for the rejection of Claim 18 is incorporated herein.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

Application/Control Number: 10/763,214
Art Unit: 2625

Page 11

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625